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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|---------------------|------------------|
| 10/709,081 | 04/12/2004 | Craig M. Sanborn | SANBP001US | 1695 |
| 27949 | 7590 | 12/18/2006 | EXAMINER | |
| LAW OFFICE OF JAY R. YABLON | | | BERGIN, JAMES S | |
| 910 NORTHUMBERLAND DRIVE | | | ART UNIT | |
| SCHENECTADY, NY 12309-2814 | | | PAPER NUMBER | |
| | | | 3641 | |

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/709,081

Applicant(s)

SANBORN, CRAIG M.

Examiner

James S. Bergin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) 16-18, 21, 28-31, 33-43, 51-65, 81-85 and 87-107 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 19, 20, 22, 23, 25, 44-50, 66-80 and 86 is/are rejected.
- 7) ☐ Claim(s) 15, 24, 26, 27 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election without traverse of group 1, claims 1-15, 19, 20, 22-27, 32, 44-50, 66-80 and 86 in the reply filed on 12/01/2006 is acknowledged. Applicant previously elected species A, sub-species e (a new sub-species defined in the interview summary of 7/26/2006 (mailed 7/31/2006), in the reply filed on 7/28/2006.
2. Claims 28, 33-37, 43, 51, 55-59, 60-62, 64 and 65 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/01/2006.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 44-50 and 66-80 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a firearm projectile that comprises a core material within at least a part of the hollow core and an expansion-inducing tip integral with the core material and protruding forward of the front of the bullet, the expansion inducing tip driving the core material rearward relative to the hollow core thereby forcing the core to expand radially outwardly upon impact with a target, does not reasonably provide enablement for an embodiment that does not include the core material integral with the expansion tip, the core material in the hollow core and expanding radially outwardly upon impact with a target . The specification does not

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make an expanding projectile commensurate in scope with these claims, namely an embodiment without the core material in the hollow core, the core material integral with the expanding tip the invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23, 19, 86 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite because it is unknown how a solid material can be porous.

Claim 23 appears to be redundant in that it appears to be claiming that which has already been claimed in claim 1.

In claim 86, line 2, "the expansion tip subassembly" lacks a proper antecedent basis. Is the "the expansion tip subassembly" precisely the same element as the "expansion-inducing tip" of claim 1?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1- 6, 8, 9, 20, 22, 23, 25 and 86, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Broad (US 854,923).

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Broad clearly anticipates the applicant's claimed expanding bullet, see especially Figs. 2, 4 and 5 and supporting sections of the specification.

Regarding claim 3, the cross sectional diameter of Broad's hollow core substantially progressively increases from the rear to the front of the bullet.

Regarding claim 6, see Broad's fig. 2.

Regarding claims 8 and 9, the surface of Broad's bullet is inherently capable of being engraved.

Regarding claims 20, 25 and 86, see Broad's Fig. 2.

Regarding claim 22, see Broad's figs. 2 and 5.

9. Claims 1- 5, 8, 9, 22, 25 and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wood (US 1,134,797).

Wood clearly anticipates the applicant's claimed expanding bullet, see especially Figs. 1 & 10. and supporting sections of the specification.

Regarding claim 3, the cross sectional diameter of Wood's hollow core substantially progressively increases from the rear to the front of the bullet.

Regarding claims 8 and 9, the surface of Wood's bullet is inherently capable of being engraved.

Regarding claims 22 and 25, see Wood's Figs. 1 and 10.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broad (US 854,923) or Wood (US 1,134,797).

Broad and Wood each disclose an expanding bullet as discussed above. Neither reference specifically discloses a bullet lubricant. The examiner takes official notice that the use of bullet lubricants was well known in the art at the time of invention, the lubricant helping to reduce gun barrel wear. In view of this official notice, it would have been obvious to one of ordinary skill in the art at the time of invention to use a bullet lubricant with either Broad's or Wood's expanding bullet, so as to help reduce gun barrel wear.

12. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (US 1,134,797).

Wood does not specifically disclose a sabot (pressure shield). The examiner takes official notice that sabots for bullets were well known in the art at the time of invention, the sabot forming a seal between the gun barrel and the bullet.

In view of the above official notice, it would have been obvious to one of ordinary skill in the art at the time of invention to provide Wood's bullet with a sabot so as to seal between the bullet and a desired gun barrel.

Allowable Subject Matter

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13. Claims 15, 24, 26, 27 and 32 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claim 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See that attached PTO FORM 892.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 571-272-6872. The examiner can normally be reached on Monday - Wednesday and Friday, 8.30 - 5.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "James S. Bergin", followed by a horizontal line.

James S. Bergin